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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,782	09/23/2003	Daniel E. Pardella	PARD 1001-1	3297
22470	7590	02/27/2006	EXAMINER	
HAYNES BEFFEL & WOLFELD LLP			DICUS, TAMRA	
P O BOX 366			ART UNIT	
HALF MOON BAY, CA 94019			PAPER NUMBER	

1774

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

6

Office Action Summary	Application No. 10/668,782	Applicant(s) PARDELLA, DANIEL E.	
	Examiner Tamra L. Dicus	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12-09-05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The 112 is withdrawn due to Applicant's amendment. The IDS is acknowledged.

Claim Objections

1. Claim 4 is objected to because of the following informalities: "the security-type verbal statement comprises security sensitive" is not grammatically correct. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "visually detectable" seller identification and theft-detering indicia is not found in the originally filled specification. There are machine-readable characters (instant page 4, [0017]), but no description or usage of visually detectable indicia or its use with a security sensitive label. The instant specification lacks a term or definition of "visually detectable" indicia. Applicant is reminded to point out in the specification where support is found. See MPEP 2163, II.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,042,842 to Green et al.

Green teaches a high security label comprising a label body having inner and outer surfaces (FIG. 2); a substrate-damaging adhesive on the inner surface (16 and 14, FIG. 2 and associated text); and the outer surface comprising visually detectable seller identification and theft-detering indicia (22, FIG. 2 and associated text, FIG. 3-6, and especially col. 3, lines 64 - col. 4, line 40, e.g. manufacturer's logo and printed symbols and incorporation of all of the above features including words or images or numbering or messages, FIG. 3-5 show machine readable bar codes). What happens if a product is stolen or what may occur is suggestive language and does not limit the claim. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See also *In re Hutchinson*, 69 USPQ 138. The same material and structure is provided, thus claims 1-4, 8-10, and 13 are met.

Regarding claims 5-6, Green teaches a paper and polymer plastic film label body (18, FIG. 2 and associated text and col. 4, line 62).

Regarding claim 7, the adhesive is either permanent adhesive, aggressive or rubber based all of which are equivalent to “paper-substrate-damaging adhesive” (col. 3, lines 25-30).

Further to the information per claims 11-12, Green also teaches at col. 3, lines 6-10 customer or company names can be spelled out and words or images also may be contained, which is inclusive of store identification and a promotional slogan.

Green also teaches if a purchaser suspects a counterfeit label, the label indicates it is counterfeit by lack of the security graphics (col. 4, lines 1-15) (further to claims 1 and 13).

Claims 1-4, 8-10, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,732,979 to Finke et al.

Finke teaches a security label (1, FIG. 1 and associated text) and identification and a graphic such as bar-coding, stock information and warning messages that spell out, “warning” (col. 4, line 64-col. 5, line 30, visually detectable seller identification and theft-detering indicia). The words alert the merchants by forming a sentence such as “Warning...customer must purchase item if label is altered, removed, or tampered with”. Adhesive material is secured to the back of the label (col. 4, lines 32-35). What happens if a product is stolen or what may occur is suggestive language and does not limit the claim. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See also *In re Hutchinson*, 69 USPQ 138. The same material and structure is provided, thus claims 1-4, 8-10, and 13 are met.

Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,805,926 to Cote et al.

Cote teaches a security label comprising a label body of paper or plastic films (col. 4, lines 56-58) having inner and outer surfaces (FIG. 2); a substrate-damaging adhesive on the inner surface (26, FIG. 3-7 and associated text); and the outer surface comprising visually detectable seller identification and theft-detering indicia (22, 20, 12, FIG. 2 and associated text, and especially col. 4, lines 5-53, e.g. company logo and product name, brand names inclusive of words, slogans, logos, and store identification. Also FIG. 2 shows machine-readable bar codes. What happens if a product is stolen or what may occur is suggestive language and does not limit the claim. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See also *In re Hutchinson*, 69 USPQ 138. Further see col. 3, lines 37-41 to theft prevention. The same material and structure is provided, thus claims 1-4 and 8-10, and 13 are met.

Regarding claims 5-6, Cote teaches a paper and polymer plastic film label body (col. 4, line 56-57).

Regarding claim 7, the adhesive is a pressure sensitive adhesive adhered and adjacent to a paper and is thus equivalent to “paper-substrate-damaging adhesive” (col. 4, line 58). See also FIG. 4 and associated text.

Further to the information per claims 11-12, Cote also teaches at col. 4, lines 7-10 any other information pertaining to the item or product may also be contained, which is inclusive of store identification and a promotional slogan.

RESPONSE TO ARGUMENTS

5. Applicant's arguments filed 12-09-05 have been fully considered but they are not persuasive.

Applicant argues that Green does not teach the instant invention because security indicia 22 are applied to the bottom surface of the paper and not outer surface. However, the Examiner cited Figures 3-4 and col. 3, lines 64-col. 4, line 40 that explicitly show and teach the surface graphics (outer surface) incorporates all the above security features, including printing on both visually detectable seller identification and theft-detering indicia. Further Applicant has not amended the claims to limit where the outer surface is, e.g. upper or lower outer surface. Applicant argues why it would not be obvious to modify Green, but the rejection is a 102(b) rejection and was not used in a 103.

Applicant argues Finke teaching void only after someone tries to remove the label and the warning phrase that states if the label is tampered with the customer must purchase it is not teaching the instant claim 1. Applicant has not persuasively argued because the indicia is on the outer surface and explicitly shows so in FIGs. 1 and 2, explicitly teaching visually detectable indicia, including the warning statement informing the customer if the label is tampered with what will happen. Further, what happens to the product if and when a product is stolen is suggestive language and does not positively limit the claim. Regardless, the indicia are still on

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the outer surface, despite timing. The teachings of Finke are therefore a 102 anticipatory reference and not obvious as Applicant alleges.

Applicant argues Cote doesn't suggest using a substrate-damaging adhesive nor the use of visually detectable theft-detering indicia on the outer surface nor alert the purchaser of the origin of the product. Applicant further alleges it may do the opposite, vouching for the authenticity. Applicant has not persuasively argued because Cote explicitly teaches security 12 being visual detectable (see col. 3, line 25) and prevents counterfeiting and pirating of the label 10 (col. 3, lines 31-41) including bar codes, product names, company logos and any other information pertaining to the product (col. 4, lines 5-10), that indeed teach the origin of the product. Cote teaches the same type adhesive as Applicant does on page 9, [0015] of the instant specification. Further Applicant has not limited the degree of damage to the substrate. Thus, Cote does not teach the opposite of claim 1 as alleged by Applicant. Cote shows at least 4 different types of indicia including what is claimed on the outer surface in Figure 2. And again, what happens to the product if and when a product is stolen is suggestive language and does not positively limit the claim. The same indicia are taught and thus must provide the same article. Further to Applicant's contentions to what may occur is not objective evidence; submission of such is needed to disprove the teachings of Cote.

Conclusively, Applicant's end product of deterring theft is to make the product less saleable as Applicant explains on page 3, [0008-009]. All of the applied prior art achieves this concept. The rejections are maintained for reasons of record.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

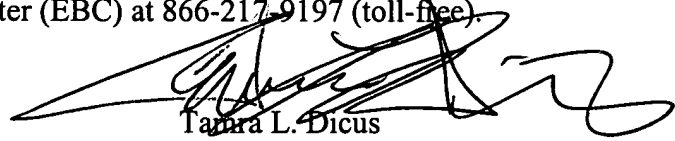
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus
Examiner
Art Unit 1774

February 13, 2006



RENA DYE
SUPERVISORY PATENT EXAMINER

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